

REMARKS

I. Status

Upon entry of this amendment, claims 1-3, as amended, and new claim 11 will be under examination. Claims 4-10 stand withdrawn as directed to nonelected subject matter.

The claim amendments are supported in the application as filed. Support for the amendment to claim 1 is found in the specification and original claim 3. Support for the amendment to claim 2 and for new claim 11 is found in the specification at, *e.g.*, page 4, lines 7-10. Claim amendments are made without prejudice to future prosecution of the originally claimed subject matter.

II. Rejection of Claims 1-3 Under 102(e)

Claims 1-3 were rejected as anticipated under Section 102(e) by U.S. Pat. No. 6,594,430. Although Applicants submit that claims 1-3, as originally filed, were not anticipated by the '430 reference, to expedite allowance of important subject matter, Applicants have amended the claims to recite that the claimed lens system has a solid immersion lens portion and the body portion formed of an integrally molded together material (claim 1) which may be an optically-clear silicon elastomer (claim 2). Applicants submit the '430 patent did not describe a lens system having solid immersion lens portion and the body portion formed of an integrally molded together material. Thus the '430 patent does not anticipate the claims.

In articulating the rejections of original claims 1-3, the Office stated “[r]egarding the limitations of claims 1-3 concerning “molded” materials, it should be noted that the matter in which the elements are made is not given significant patentable weight in a product claim since these features do not further limit the claimed invention structurally.” However, the recitation in original claim 3, now incorporated into claim 1, that the solid immersion lens portion and the body portion of the device are “formed of an integrally molded together material” is a description the *structure* of the lens system. Figures 7 and 16 and page 22, second and third paragraph, provide an example (for illustration and not for limitation) of a lens in which the body portion (306) and lens portion (302) are of an integrally molded together material. In contrast, the air bearing slider (64) of the '430 patent, considered by the Office to correspond to a body

portion of the instant invention, is not integral with the lens (20) of the '430 device. Accordingly, the '403 patent did not anticipate at least original claim 3, and does not anticipate any of the now pending claims.

Applicants respectfully submit this rejection be withdrawn.

III. Request for Rejoinder


Claims 6-9 depend from, and incorporate all of the limitations of, claim 1. Should the Examiner conclude that claim 1 as amended is free of art, Applicants request that claims 6-9 be rejoined and allowed.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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